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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,700	02/27/2004	James Floyd Ferguson	JF2003	9285
32184	7590	12/29/2005		
AARON R. CLEMENTS/HURLEY, REYES & GUINN 1805-13TH ST. LUBBOCK, TX 79401			EXAMINER PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/789,700

Applicant(s)

FERGUSON, JAMES FLOYD

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's amendment submitted 19 October 2005. The applicant presented no claim amendments. Claims 1-5 are pending in the application, as presented in the claim set of 23 July 2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 103***

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner (US 5,042,193) in view of Cho (US 6,062,385).

Steiner discloses a fishing tackle utility box with two boxes in back-to-back relationship (see Figures 2 and 5).

Cho discloses a utility box with an integral main body **2**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the boxes of Steiner in one piece in order to keep any gear that is retained in the individual compartments together. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

As such, the box of Steiner-Cho discloses a tubular main body **14, 15 & 16**, a center partition **13** bisecting the tubular main body between two open ends, a network of partitions **22, 23 & 24**, a handle **40**, two end plates **12**, hinge **18**, and closure means **20**.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner-Cho as applied to claim 1 above, and further in view of Rathbun (US 2,046,133).

Steiner-Cho discloses the claimed invention except for the octagonal shape.

Rathbun discloses an octagonal-shaped box. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the box of Steiner-Cho with an octagonal shape in order to reduce the sharpness of the corners. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Art Unit: 3728

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner-Cho-Rathbun as applied to claim 2 above, and further in view of Carter (Des. 379,562).

Steiner-Cho-Rathbun discloses central cavity 21. Steiner-Cho-Rathbun discloses the claimed invention except for the plurality of horizontal trays.

Carter discloses a plurality of horizontal trays within a cavity (see Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Steiner-Cho-Rathbun with a plurality of horizontal trays as taught by Carter in order to store a large number of small, loose items.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner-Cho-Rathbun as applied to claim 2, or Steiner-Cho-Rathbun-Carter as applied to claim 3 above, and further in view of Straface (US 6,849,038).

Steiner-Cho-Rathbun and Steiner-Cho-Rathbun-Carter disclose the claimed invention except that they use a clasp instead of a hook-and-loop closure means. Straface shows that a hook-and-loop closure means was an equivalent structure known in the art. Therefore, because these two closure means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Straface for the clasp of Steiner.

***Response to Arguments***

8. Applicant's arguments filed 19 October 2005 have been fully considered but they are not persuasive.

9. In response to applicant's argument that Cho is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cho is reasonably pertinent to a unitary utility box that opens from both ends. Further, Cho represents a reasonable expectation of success in the formation of Steiner in one piece.

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion can be found in the knowledge generally available to one of ordinary skill in the art. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit*

Art Unit: 3728

Stove Works, 150 U.S. 164 (1893). Cho represents a reasonable expectation of success in the formation of Steiner in one piece.

11. In response to the applicant's arguments that the combination of Steiner-Cho does not produce a tubular main body, the use of the term "tubular" does not impose any length requirements on the structure of the claim. A tube may be short in length, as is the case in the combination of Steiner-Cho. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. In response to applicant's argument that the horizontal trays taught by Carter would be unsuitable for use in the instant invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, while the claim language recites that each of the trays may be inserted into or withdrawn from the central cavity, this does not require independent insertion/removal. Structure wherein all of the trays are inserted together and all of the trays are withdrawn together, meets the claim language as presented.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
21 December 2005

  
**JILA M. MOHANDESI**  
**PRIMARY EXAMINER**